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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/786,436	02/25/2004	Henry J. McVicker	513779600009	4874
28104	7590	03/29/2006	EXAMINER	
JONES DAY			HECKENBERG JR, DONALD H	
77 WEST WACKER			ART UNIT	
CHICAGO, IL 60601-1692			PAPER NUMBER	

1722

DATE MAILED: 03/29/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/786,436

Applicant(s)

MCVICKER ET AL.

Examiner

Donald Heckenberg

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 21 February 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-10 and 19-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 22 is/are allowed.
- 6) ☒ Claim(s) 1,8-10,19-21 and 23-25 is/are rejected.
- 7) ☒ Claim(s) 2-7 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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1. The indicated allowability of claims 1-10 and 19-25 are withdrawn upon reconsideration of the prior art previously of record. Rejections based on the prior art are set forth below.

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 8 and 9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

Claim 8 recites that the mounting means comprises one or more retaining surfaces and that the insert comprises one or more retaining means that engage the retaining surfaces. Claim 9 appears to switch the elements which include the retaining surfaces and retaining means defined in claim 8. That is, the retaining surfaces are said to comprises a shoulder on the mold insert instead of the mounting means, whereas the retaining means is part of the mounting means. Based on the disclosure of the application, it appears as though the shoulder is to be part of the mold insert, and the retaining means are retaining blocks

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(see Fig. 4). The claim will therefore be interpreted as such in the rest of this Office Action. Appropriate clarification and correction, however, is required.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. The factual inquiries set forth in Graham v. John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various

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claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary.

Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 1, 8, 19-21, and 23-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over McVicker (U.S. Pat. No. 5,656,226; previously of record) in view of Kim et al. (U.S. Pat. No. 6,149,420; previously of record).

Initially it is noted that several of the claims of the instant application recite "means for" clauses. These elements have been interpreted as invoking 35 U.S.C. § 112, sixth paragraph, and thereby are limited to the corresponding structure described in the specification and equivalents thereof. In re Donaldson, 16 F.3d 1189, 1194, 29 USPQ2d 1845, 1950 (Fed. Cir. 1994); MPEP § 2181.

Claim 1 recites a "means for mounting" in line 6. The specification of the instant application discloses a means for

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mounting as the projections described at ¶ 18, or the retaining surfaces described at ¶ 20.

Claim 3 recites a "means for fastening" at line 2. Similarly, claim 10 defines a "means for fastening" at line 2. The specification of the instant application discloses the means for fastening as screws as described at ¶ 18.

Claim 5 recites a "means for providing a substantially smooth surface" at line 1. The specification of the instant application discloses this means as a cap as described at ¶ 19.

McVicker discloses a method and apparatus for injection-molding a thermoplastic device. The mold has an inner surface (102) defining a mold cavity (106), the cavity defining the shape of the molded article (see Fig. 10). The apparatus includes an insert (114) used as a mold component in a mold. The insert is sized and dimensioned to fit within a recess (112) in the inner surface of the mold cavity (Fig. 10). The insert comprises a first surface having an area (80) that on that is a complement of the field of integrally molded hooks on the molded article (see Figs 4, 6, 11A, and 11B; cl. 5, ll. 9-15).

McVicker further discloses the insert as comprising a plurality of plates (90), each plate having a side edge (80), the plates being stacked together, with the side edges defining a portion of the first surface of the mold insert and the hook-

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shaped cavities being formed in the side edges (see Fig. 11A & 11B). The insert also comprises spacer plates (100) positioned between the hook-cavity plates, such that the molded hooks on the surface of the molded article are an array of spaced rows of hooks (see Fig. 11A & 11B).

McVicker does not disclose a means for mounting the insert in the inner surface of the mold cavity.

Kim discloses an injection molding machine. The molding machine is provided with an insert structure (12). The insert is detachably attached to the mold with a plurality of locking fasteners that act as a retaining means on the side surfaces of the insert (Fig. 5 & cl. 6, ll. 35-37). Kim notes that this configuration of the insert is advantageous because it does not require separating a core mold from a bottom clamp plate when the insert is changed with another insert having a different configuration (cl. 6, ll. 37-41).

It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to have modified the device injection molding apparatus disclosed by McVicker as such to have made the insert detachably attached to the mold with a plurality of locking fastener projections because this configuration of the insert is advantageous as it does not require separating a core mold from a bottom clamp plate when

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the insert is changed with another insert having a different configuration as suggested by Kim.

8. Claim 22 is allowed.

9. Claims 2-7 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

10. Claims 9 and 10 would be allowable if rewritten to overcome the rejections under 35 U.S.C. 112, 2nd paragraph, set forth in this Office Action and to include all of the limitations of the base claim and any intervening claims.

11. The following is a statement of reasons for the indication of allowable subject matter:

The prior art of record fails to teach or suggest a insert for use as a mold component in a mold for the manufacture of a molded article as recited in claims 2-7, 9, 10, and 22.

With respect to claims 2-7 and 22, the closest prior art disclosed by McVicker and Kim is described above, or Korsch (U.S. Pat. No. 3,784,344). McVicker and Kim fail to teach or



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suggest the mounting means as comprising one or more projections as recited in claims 2 and 22. Moreover, it does not appear to be reasonable to combine the blow-molding structure disclosed by Korsch with the injection molding apparatus disclosed by McVicker and Kim in a way to render obvious the combinations of claims 2 and 22.


With respect to claims 9 and 10, the closest prior art is disclosed by McVicker, Kim, and Chittenden et al. (U.S. Pat. No. 3,380,121; previously of record). McVicker and Kim fail to teach or suggest the mounting means comprises a retaining block and the insert comprises a shoulder that engages the retaining block as recited in claim 9. Moreover, it does not appear to be reasonable to combine the blow-molding structure disclosed by Chittenden with the injection molding apparatus disclosed by McVicker and Kim in a way to render obvious the combinations of claims 2 and 22.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald Heckenberg whose telephone number is (571) 272-1131. The examiner can normally be reached on Monday through Friday from 9:30 A.M. to 6:00 P.M.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Duane Smith, can be reached at (571) 272-1166. The official fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <<<http://pair-direct.uspto.gov>>>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free).

  
Donald Heckenberg  
Primary Examiner  
A.U. 1722

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